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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,757	02/05/2004	Michael Rock	03-597-A	5681

20306 7590 05/23/2006

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EXAMINER

EARLY, MICHAEL JACOBY

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/772,757

Applicant(s)

ROCK, MICHAEL

Examiner

Michael J. Early

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14 and 17 is/are rejected.
- 7) ☒ Claim(s) 6, 13, 15, 16, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/17/04; 7/6/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Specification**

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains phrases that can be implied – "disclosed" and "claimed" (see Abstract, first sentence). Correction is required. See MPEP § 608.01(b).

### **Claim Objections**

Claims 3 and 11 are objected to because of the following informalities:

- Both claims recite that the anesthetic agent is selected from a group of gases "consisting" of isoflurane, desflurane and sevoflurane. The term "consisting" has been interpreted as implying that a composition, material, etc. (i.e. gas) is composed solely of the expressed components (i.e. isoflurane, desflurane and sevoflurane). The term "comprising", is interpreted as implying that a composition, material, etc. is composed of the desired components; however, its formulation may be altered to an extent (e.g. the percentage and/or type of isoflurane, desflurane and sevoflurane that the gas is composed of, or including another material in the gas' composition). It is recommended that the term "consisting" be removed from the claims and replaced with the term

--comprising--. This claim has been examined based upon this presumption to further the prosecution of this present application.

Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 9-12, 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Georgieff et al. (U.S. 5,520,169).

In regard to claims 1-3, 5, 7 and 11; Georgieff et al. disclose:

- an entrance port (2 – expiration line)
- a bypass circuit (8 – anesthetic gas transport line);
- means for (16 – pump device) moving the waste anesthetic gas stream through the device (see col. 5, lines 8-10);
- a first condensation chamber (17 – first pressure vessel);
- means for (18 – compression unit) removing the condensed water from the first condensation chamber (see col. 6, lines 14-18);
- a second condensation chamber (19 – second pressure vessel);
- means for recovering the one or more condensed, recovered anesthetic agents from the second condensation chamber (26 – pump device; col. 5, lines 47-51);
- a storage canister or storage tank (24 – third pressure vessel);
- means for evacuating the remainder of the waste anesthetic gas stream from the device (see col. 6, lines 44-46);
- the one or more anesthetic agent is a potent, inhalational anesthetic agent (xenon; col. 1, lines 61-62; col. 4, lines 42-45);

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- the one or more anesthetic agent is selected from the group comprising of isoflurane, desflurane, and sevoflurane (obvious design choice – the use of isoflurane as an anesthetic agent is old in the art; col. 1, lines 22-30);
- the means for moving the waste anesthetic gas stream through the device is provided by one or more pumps (16 – pump device).

In regard to claims 9, 10, 12, 14 and 17; Georgieff et al. disclose an apparatus that inherently is comprises a methodology comprising:

- collecting the waste anesthetic gas (see col. 5, lines 60-62);
- differentially condensing the one or more anesthetic agents from the other constituents in the waste anesthetic gas (see col. 4, lines 60-67; col. 5, lines 1-57);
- recovering the one or more anesthetic agent (see col. 1, lines 60-62; col. 4, lines 42-45);
- the one or more anesthetic agent is a potent, inhalational anesthetic agent (xenon; col. 1, lines 61-62; col. 4, lines 42-45);
- the condensing is accomplished in a cooled chamber (19 – second pressure vessel) (see col. 5, lines 15-28; col. 6, lines 19-22);
- the one or more recovered anesthetic agent is recycled and reused (see col. 6, lines 36-46);
- the one or more recovered anesthetic agent is placed into a pressurized chamber (24 – third pressure vessel; col. 6, lines 36-46).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georgieff et al.

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Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georgieff et al. as applied to claim 1 above, and further in view of Hickie et al. (U.S. 5,676,133).

However, Georgieff et al. do not disclose:

- details related to what the device is connected to;
- details related to a wall port.

Hickie et al. teach of an apparatus that is used to prevent the contamination of a hospital's post anesthesia care unit (see Abstract). Hickie et al. further disclose of a scavenging and diagnostic system (12) that is comprised of a mask (16), which is used to administer anesthesia to a patient, a vacuum port (240), which is used to vent the used anesthesia to the atmosphere, and a housing or shell (230), which is located in-line between the mask and vacuum port, to be old in the art (see col. 7, lines 35-52; Figure 1).

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the existing apparatus of Georgieff et al. by connecting the apparatus in-line between the component that administers anesthesia to patients and a vacuum port, as taught by Hickie et al., so that expired gas can be easily vented to the atmosphere (see col. 7, lines 35-52).

**Allowable Subject Matter**

Claim 20 is allowed.

Claims 6, 13, 15, 16, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Berry (U.S. 6,729,329 B2) teaches of a system that removes gas components from waste anesthetic gases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Early whose telephone number is (571) 272-3681. The examiner can normally be reached on Monday - Friday, 7am - 4:30pm.

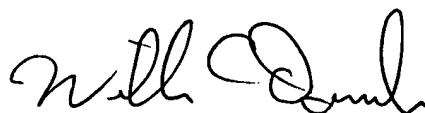
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJE  
5/15/06

Michael J. Early  
Patent Examiner  
Art Unit 3744



**WILLIAM DOERRLER  
PRIMARY EXAMINER**